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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,476	03/13/2001	Benjamin Mark Goss	002918.00007	8766

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,476

Applicant(s)

GOSS ET AL.

Examiner

Clement B. Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 13, 01.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-35, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-35, do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-35, are rejected as being directed to non-statutory subject matter. Applicant's is advised to imbed a computer in the body of the claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3628

3. Claims 1-35, are rejected under 35 U.S.C. 102(e) as being anticipated by Doeer et al (Hereinafter Doeer U.S Patent 6,473, 745).

As per claims 1-4, Doeer discloses a method of electronically providing financial advice to a user, comprising:

- a. receiving personal data from the user;
- b. receiving financial objective data relating to one or more financial objectives from the user;
- c. storing one or more financial rules. (see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- d. processing said personal data and financial objective data according to said financial rules so as to determine the suitability of the financial objective data to the personal data; and e. if the financial objective data is determined, at step d, not to be suited to the personal data, transmitting a request to the user to confirm the data received from the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claims 5-8, Doeer discloses a method of electronically providing financial advice to a user, comprising:

- a. receiving personal data from the user;
- b. receiving financial objective data relating to one or more financial objectives from the user;
- c. storing one or more financial rules. (see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- d. processing said personal data and financial objective data according to said financial rules so as to determine the suitability of the financial objective data to the personal data; and
- e. if the financial objective data is determined, at step d, not to be suited to the personal data, initiating a communication between the user and a financial adviser. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claim 9-12, Doeer discloses a method of receiving financial advice from an electronic apparatus, comprising:

Art Unit: 3628

- a. sending personal data to an electronic apparatus;
- b. sending financial objective data relating to one or more financial objectives to the electronic apparatus; and
- c. if said personal data is determined by the electronic apparatus not to be suited to said financial objective data according to financial rules stored by the electronic apparatus, receiving a request to confirm the data sent to the electronic apparatus. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claims 13-16, Doeer discloses a method of receiving financial advice from an electronic apparatus, comprising:

- a. sending personal data to an electronic apparatus;
- b. sending financial objective data relating to one or more financial objectives to the electronic apparatus; and
- c. if said personal data is determined by the electronic apparatus not to be suited to said financial objective data according to financial rules stored by the electronic apparatus, receiving an initiation of a communication with a financial adviser. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claim 17-19, Doeer discloses a method of electronically providing financial advice to a user, comprising:

- a. receiving personal data from a user,
- b. receiving financial objective data relating to one or more financial objectives of the user;
- c. storing one or more financial rules (see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- d. storing financial data not specific to said user;
- e. in response to a change in any of said personal data, financial objective data, financial rules or financial data, processing said personal data, financial objective data and financial data according to said financial rules so as to generate said financial advice, and f. transmitting said financial advice to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

Art Unit: 3628

As per claim 20, Doeer discloses a method of electronically providing financial advice to a user, comprising:

- a. receiving personal data from a user,
- b. receiving financial objective data relating to one or more financial objectives of the user,
- c. storing one or more financial rules including expected personal data values;
- d. storing text passages including variables (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- e. compiling said financial advice by matching said personal data to said expected personal data values so as to select one or more of said business rules, applying said selected one or more business rules so as to select one or more of said text passages, calculating values of the variables of the selected text passages, and compiling said selected text passages and calculated values to generate a financial advice document; and
- f. transmitting said financial advice document to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claims 21-30, Doeer discloses a method of electronically providing financial advice to a user, comprising.

- a. receiving personal data from a user;
- b. receiving financial objective data relating to one or more financial objectives from the user;
- c. storing one or more financial rules (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- d. processing said personal data and financial objective data according to said financial rules so as to generate said financial advice; and
- e. transmitting said advice to the user;

wherein the generated financial advice, the values of the personal data and financial objective data from which the financial advice was generated are stored so as to be

Art Unit: 3628

accessible subsequent to said financial advice being transmitted to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claim 31, Doeer discloses a system for providing financial advice automatically to a user terminal from a server connected to a network, comprising:

a. a database storing personal data and financial objective data relating to one or more financial objectives of the user, received from the user over the network (see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)

b. a rules engine storing one or more financial rules and processing said personal data and financial objective data according to said financial rules so as to determine the suitability of the financial objective data to the personal data(see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)

and

c. a communications interface connected to the network, for transmitting a request to the user to confirm the data received from the user if the rules engine determines that the financial objective data is not suited to the personal data. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claim 32, Doeer discloses a system for providing financial advice automatically to a user terminal from a server connected to a network, comprising:

a. a database storing personal data and financial objective data relating to one or more financial objectives of a user, received from the user over the network(see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)

b. a rules engine storing one or more financial rules and processing said personal data and financial objective data according to said financial rules so as to determine the suitability of the financial objective data to the personal data(see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67) and

c. a communications interface for initiating a communication between the user and a financial adviser if the rules engine determines that the financial objective data is not suited to the personal data. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

Art Unit: 3628

As per claim 33, Doeer discloses a system for providing financial advice automatically to a user terminal from a server connected to a network, comprising:

- a. a database storing personal data and financial objective data relating to one or more financial objectives of a user, received from the user over the network;
- b. a database storing financial data not specific to said user(see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- c. a rules engine storing one or more financial rules and processing said personal data and financial objective data according to said financial rules in response to a change in any of said personal data, financial objective data, financial rules or financial data so as to generate said financial advice, and
- d. a communications interface connected to the network for transmitting said financial advice to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

As per claim 34, Doeer discloses a system for providing financial advice automatically to a user terminal from a server connected to a network, comprising.

- a. a database storing personal data and financial objective data relating to one or more financial objectives of the user, received from the user over the network;
- b. a rules engine storing one or more financial rules including expected personal data values(Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- c. a database storing text passages including variables;
- d. a compiler for compiling said financial advice by matching said personal data to said expected personal data values so as to select one or more of said business rules, applying said selected one or more business rules so as to select one or more of said text passages, calculating values of the variables of the selected text passages, and compiling said selected text passages and calculated values to generate a financial advice document; and
- e. a communications interface connected to the network for transmitting said financial advice to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

Art Unit: 3628

As per claim 35, Doeer discloses a system for providing financial advice automatically to a user terminal from a server connected to a network, comprising:

- a. a database storing personal data and financial objective data relating to one or more financial objectives of the user, received from the user over the network;
- b. a rules engine storing one or more financial rules and processing said personal data and financial objective data according to said financial rules so as to generate said financial advice (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67)
- c. a communications interface connected to the network for transmitting said advice to the user, and
- d. a store for storing the generated financial advice, the values of the personal data and financial objective data from which the financial advice was generated, so as to be accessible subsequent to said financial advice being transmitted to the user. (Note abstract and see column 2 lines 19-60 and column 3 lines 35-67 and column 4 lines 51-67).

Conclusion

4. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Lange (US 6, 321, 212 Patent) teaches financial products having a demand based adjustable return and trading exchange therefor.

Silverman (US Patent 5, 077, 665) teaches distributing matching.

Musmanno (US Patent 4, 346, 442) teaches securities brokerage cash management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

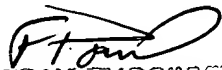
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Ponvil can be reached on 703-305-9779. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Art Unit: 3628

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

September 6, 2005


FRANTZY POINVIL
PRIMARY EXAMINER
Au 3628